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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,498	12/14/2001	William E. Pence	3652/0K015	5619

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EXAMINER	
HEWITT II, CALVIN L	

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/017,498	PENCE ET AL.	
	Examiner	Art Unit	
	Calvin L Hewitt II	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Status of Claims

1. Claims 1-21 have been examined.

Response to Arguments/Amendments

2. The Applicant has amended claims 1 and 17-21 to include the limitation of transmitting, renewing, and updating a license file "without notifying a user". Hortsmann teaches a process for relicensing where a user requests licenses for additional installations that includes transmitting, renewing, and updating a license file (column 4, lines 12-38). Hortsmann does not specifically recite notifying a user during the transmitting, renewing or updating process (column 4, lines 12-38), therefore the prior art combination continues to read on the Applicant's claims. The Examiner collated the Specification in search of a further explanation, or description of Applicant's licensing process that includes the step of processing a user's license file "without notifying a user". Other than a passing reference (Specification, page 8, lines 7-8) the Specification is silent. To the contrary, a user in the Applicant's system is notified that he/she/they are to receive "something" or have knowledge of the existence of licenses as requests for content and licenses are "validated" and invalidation results in the user receiving an error message (figure 2A and 3B) and files are stored on a user's computer in the clear (figure 2B). Further, the Applicant does not have support

for the following: "renewing the parameters without notifying the user" and "update said license file parameter without notifying the user".

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Applicant's Specification is silent regarding the following: "renewing the parameters without notifying the user" (claims 1, 19 and 20) "update said license file parameter without notifying the user" (claims 17 and 18).

Claims 2-18 are also rejected as they depend from claim 1.

5. Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Applicant's Specification is silent regarding the following: "renewing the parameters without notifying the user" (claims 1, 19 and 20) "update said license file parameter without notifying the user" (claims 17 and 18). Further the Specification does not provide one of ordinary skill with the necessary data for implementing the Applicant's system regarding transmitting a license file "without notifying a user", particularly in light of the Applicant's teachings which suggest to one of ordinary skill that the user has or explicit knowledge of the existence or at least knowledge of the functionality of the license with respect to the content. In addition it is not clear to one of ordinary skill whether the user never has knowledge of the license, is not informed of the specific download, or somewhere in-between.

Claims 2-18 are also rejected as they depend from claim 1.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-21 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Applicant's Specification is silent regarding the following: "renewing the parameters without notifying the user" (claims 1, 19 and 20) "update said license file parameter without notifying the user" (claims 17 and 18). Further the Specification does not provide one of ordinary skill with the necessary data for implementing the Applicant's system regarding transmitting a license file "without notifying a user", particularly in light of the Applicant's teachings which suggest to one of ordinary skill that the user has or explicit knowledge of the existence or at least knowledge of the functionality of the license with respect to the content. In addition it is not clear to one of ordinary skill whether the user never has knowledge of the license, is not informed of the specific download, or somewhere in-between.

Claims 2-18 are also rejected as they depend from claim 1.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-7 and 10-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivera et al., U.S. Patent No. 6,056,786 in view of Hortsmann, U.S. Patent No. 6,009,401.

As per claims 1-7 and 10-21, Rivera et al. licensing system comprising:

- A processor and memory storing instructions for controlling the processor (figures 1; column/line 4/54-6/2)
- creating a license file having one or more parameters (column 8, lines 32-34)
- transmitting content from a provider system to a user (column/line 5/52-6/2)
- comparing license parameters to determine whether or not a user is allowed to access content and renewing parameters in the license file to allow continued access to the content by the user in accordance with license parameters (column/line 8/35-9/14)
- storing license file parameters using a subscription system (figure 3)
- storing downloaded content on a user database (figure 3; column/line 5/52-6/2)

- a subscription management service operable to monitor and store one or more license file parameters (figure 3)

Rivera et al. also teach client application for receiving user input and providing user input to communication application, license storage and content storage, as it would have been obvious to combine the server that stores the monitoring routine with the server that disseminates the software (figures 3-5B; column/line 5/52-6/57). However, Rivera et al. do not explicitly recite transmitting a license file to a user. Hortsmann teaches a provider system transmitting without notifying a user a license file that contains user technical information and type of content, for storage on a user system (figures 1 and 2; column/line 3/43-4/11). Hortsmann also teaches a license file stored on a license server and client system (figures 1 and 2), a license server generating the license file for a user (column/line 3/65-4/11), storing license file parameters in a registry (column/line 3/43-4/11). Therefore, it is at least obvious that the file was created and transferred via the license server. Rivera et al. do not explicitly recite disseminating content with license. On the other hand, Rivera et al. teach disseminating content using a server (column/line 5/52-6/2), while Hortsmann teaches delivering content with license offline (figure 3) hence it would have been obvious to one of ordinary skill to distribute the content with the license electronically. Therefore it would have been obvious to one of ordinary skill to combine the teachings of Rivera et al.

and Hortsmann in order to include license terms such as the number of computers allowed to access software (i.e. number of licenses), access license data stored on a user system ('401, column 3, lines 44-51), determine whether a customer is in compliance with the license terms, offer the customer the opportunity to come under license compliance without interrupting the customer's business and update the license file accordingly (e.g. purchase extra licenses) ('786, figures 5A-B; column 8, lines 35-47; '401, column 3, lines 44-51).

9. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivera et al., U.S. Patent No. 6,056,786 and Hortsmann, U.S. Patent No. 6,009,401 as applied to claim 1 in further view of Johnson et al., U.S. Patent No., 5,023,907.

As per claims 8 and 9, Rivera et al. teach a license compliance monitoring system (figure 3) while, Hortsmann teaches transmitting a license file to a user and without notifying said user (figures 1 and 2; column/line 3/43-4/11). However, neither reference explicitly recites creating individual license files for individual content items and one license file for a plurality of items. Johnson et al. teach a licensing system that creates individual license files for individual content items and one license file for a plurality of items (figure 2). Therefore, it would have been obvious to combine the systems of Rivera et al., Hortsmann and Johnson

et al. in order to permit an end-user to more accurately account for licensed products ('907, figure 2).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Calvin Loyd Hewitt II

December 9, 2003

JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600